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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/592,284	06/12/2000	FRANCOIS SMOLAREK	106498	5209

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OLIFF & BERRIDGE, PLC
P.O. BOX 19928
ALEXANDRIA, VA 22320

EXAMINER

HECKENBERG JR, DONALD H

ART UNIT	PAPER NUMBER
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1722

DATE MAILED: 12/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/592,284

Applicant(s)

SMOLAREK, FRANCOIS

Examiner

Donald Heckenberg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-11,13-22,24-33,35-44,46-55,57-76,78-87 and 89-119 is/are pending in the application.
- 4a) Of the above claim(s) 87,89-98,116 and 117 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 80,81 and 101 is/are allowed.
- 6) ☒ Claim(s) 1, 3-11, 13-22, 24-33, 35-44, 46-55, 57-76, 78-79, 82-86, 99-100, 102-115, and 118-119 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

1. A request for continued examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 3, 2003 has been entered.

2. Claims 87, 89-98, and 116-117 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Claims 87, 89-98, and 116-117 are directed to a method for manufacturing a stick of cosmetic product, whereas the originally presented claims are directed to a mold for manufacturing a stick. These two inventions are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. MPEP § 806.05(e). In this case, the apparatus as claimed can be used to practice another and materially different process such as a

process wherein the molding material is injected into the mold rather than by "pouring" the material into the mold as required by the method claims.

Applicant asserts that claims are sufficiently related such that no further search would be necessary, and thus examination could be done without a serious burden on the Examiner.

The claims are not sufficiently related such that no further search and consideration would be required. For example, claim 87 recites that the method is for manufacturing a stick of a cosmetic product. In a method claim, the intended use carries weight, therefore a significant search would be done in cosmetic product classifications. However, in apparatus claims, the intended used is not germane to issue of patentability. Therefore, extended searches in the cosmetic product classifications is not necessary. Further, this difference in relevance of the intended use of a method and apparatus requires a different consideration. Therefore, there is a serious burden in examining method claims in addition to the apparatus claims of the instant application. Accordingly, the restriction requirement is proper.

Since Applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution

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on the merits. Accordingly, claims 87, 89-98, and 116-117 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

It is noted that in the version of the claims that Applicant filed with amendments on October 3, 2003, claim 97 recites a "mold according to claim 87..." Claim 97 previously recited a "method according to claim 87..." This change to the claim is properly marked as an amendment (that is, underlining the new word "mold" and bracketing the deleted word "method"), nor has claim 87 been amended to recite a mold instead of a method. It will therefore be assumed that claim 97 was still meant to be a method claim, and that word "mold" is a typographical error.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 3-11, 13-22, 24-33, 35-44, 46-55, 57-76, 78-79, 82-86, 99-100, 102-115, and 118-119 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject

matter which was not described in the disclosure in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

Independent claims 1, 11, 22, 33, 44, 55, 75, 87, and 99 have been amended to recite that the claimed mold comprises recesses (or notches) with "at least one of said recess having longitudinal edges having a length on the external surfaces, the edges not touching each other over at least a major part of their length when the mold is at rest." (claim 1, ll. 5-7). The specification does not contain any reference to edges of the recesses not touching over a major portion of their length while the mold is at rest. Figure 2 of the instant application does show the recesses (12) with edges that are not touching. However, Figure 2 only shows a single cross section, and thus does not show the recesses not touching "over at least a major portion of their length." Further, it not specified that the mold is "at rest" in figure 2. As there is no description in the originally filed disclosure for this edges of the recesses not touching each other over a major portion of their length while the mold is at rest, this limitation constitutes new matter.

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5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 3-7, 9, 33-39, 42-44, 46-50, 53-54, 69, 72-73, 75-76, 78-79, 84-86, 99-100, 102-104, 106, 110-115, and 118 are rejected under 35 U.S.C. 102(b) as being anticipated by Henning (U.S. Pat. No. 3,934,810; previously of record).

Henning discloses a molding apparatus wherein the mold has a side wall with an external surface and an internal surface configured to come into contact with the products (figures 3 and 4). The side wall is further provided with recesses facilitating radial deformation of the mold. (col. 1, ll. 59-66). Henning further discloses the recesses to be notches (87) made in the side wall of the mold, uniformly distributed in a periphery of the mold (see figure 8). Henning also discloses the notches to extend over substantially an entire height of the mold all the way to the bottom of the mold beyond the bottom of the cavity (figure 7), and the bottom of the notches to be rounded (93). As shown in scale of figure 8, Henning further teaches that the thickness of the side wall between the notches and the cavity is

greater than 1 mm, and that the notches have a depth greater than 4 mm.

Henning further discloses in the embodiment shown in figures 2 and 5-6, the notch to formed in the side of the mold such that the depth of the notch decreases towards the bottom of the mold. Henning also discloses the mold to have a top portion with a flange surrounding the opening in the mold (see figure 2).

Henning discloses that when the mold is an at rest position shown in figure 6, the walls the edges 27' of the notch are to not touch each other over a major portion of their length (col. 3, ll. 31-36).

Claims 69, 72-73, 86, and 114 recite that the mold is configured to be filled with a cosmetic product. The actual intended use of the apparatus, whether it be to make a cosmetic product or anything else, is not germane to the issue of patentability of the apparatus claims. If the prior art structure is capable of performing the claimed use, then it meets the claim limitation(s). In re Casey, 370 F.2d 576, 580 152 USPQ 235, 238 (Cust. & Pat. App. 1967); In re Otto, 312 F.2d 937, 939, 136 USPQ 458, 459 (Cust. & Pat. App. 1963); MPEP § 2115. In the instant case, Henning teaches the mold to be used with "a hardenable mixture" (col. 1, l. 6), and to comprise a

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completely closed cavity (81) for containing the mixture (see fig. 7). Therefore, the apparatus of Henning is capable of being used with a hardenable mixture such as that which would form a cosmetic product, and therefore anticipates the limitations of claims 69, 72-73, 86, and 114.

Claim 118 recites that the mold is made of a material that is physically and chemically compatible with polydimethyl siloxane silicon at a temperature of about 100°C. Although Henning does not disclose the use of the apparatus for molding polydimethyl siloxane silicon, this actual use of this material is a limitation is directed towards the intended use of the apparatus, which is not germane to the issue of patentability as discussed above. Henning does disclose that the apparatus is capable of molding hardenable materials. (see for example, col. 1, ll. 3-6). Given this structure, the mold of Henning would inherently have to be made of a material physically and chemically compatible with polydimethyl siloxane silicon.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at

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the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 8, 10, 40-41, 51-52, 82-83, 105, and 107 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henning.

Henning discloses the mold as described above. Henning does not disclose the mold to have sixteen to twenty notches, or more specifically, eighteen notches. However, Henning does teach that the number of notches is not critical, and that more or less can be added (see col. 4, ll. 30-36). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the mold of Henning as such to have provided eighteen notches because number of notches

is not critical and could be adapted to meet a particular use of the apparatus as suggested by Henning.

10. Claims 11, 13-22, 24-32, 55, 57-68, 70-71, 74, 108-109, 121-122, and 125 rejected under 35 U.S.C. 103(a) as being unpatentable over Henning as applied to claims 1, 3-10, 33, 35-44, 46-54, 69, 72-73, 75-76, 78-79, 82-86, 99-100, 102-107, 110-115, and 118 above, and further in view of Fox et al. (U.S. Pat. No. 3,937,438; previously of record).

Henning does not disclose the mold cavity-opening to have a sloping bottom wall, or a cavity having a part formed by two successive conical surfaces converging towards an opening in the mold, or the cavity to be partially defined by a conical surface.

The mold cavity-opening shape determines the shape of the product to be manufactured. Henning teaches different cavity shapes which would form products of different shapes (compare cavity 25 in the embodiment shown in figures 2-4, with cavity 81 shown in figures 7-8). In the same field of endeavor, Fox teaches another example of a different cavity shape (21) to produce different shaped products (45). Therefore, it is known in the art that the shape of the cavity may be manipulated in order to produce products of different shapes.

Thus, it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the mold cavity of Henning as such to have a slopping bottom wall, two successive converging conical surfaces, or be partially defined by a conical surface because these cavity shapes would have allowed for the molding of correspondingly shaped products as is suggested by Henning and Fox.

11. Claim 119 is rejected under 35 U.S.C. 103(a) as being unpatentable over Henning in view of Llorente Hompanera (U.S. Pat. No. 6,197,359).

Henning discloses the molding apparatus as describe above. Henning notes that the mold is made of flexible elastomeric materials (col. 2, ll. 43-47), but does not specify a specific material.

Llorente Hompanera discloses that fluoro silicone rubber materials are known for making flexible elastomeric molds (col. 1, ll. 38-46 and ll. 63-64).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have used a fluoro silicone rubber for construction of the mold of Henning because such a material is known for its flexible elastomeric properties as suggested by Llorente Hompanera.

12. Applicant's arguments filed October 3, 2003 have been fully considered but they are not persuasive.

Applicant argues that Henning does not disclose the recesses having longitudinal edges not touching each other over at least a major portion of their length when the mold is at rest as recited in claims 1, 33, 44, 75, and 99.

Henning does note that figure 1 shows the mold to be at rest with the edges 27' of the recess to be abutting one another (col. 2, ll. 58-60). However, Figure 6 of Henning shows the mold in a state at which the edges 27' of the recess not abutting one another. Henning does not designate this position as "at rest" or "not at rest," but rather describes this position as being the position at which the vacuum has been applied to expand the mold to allow for product removal (col. 3, ll. 5-30). Henning therefore does not clearly define what constitutes "at rest."

As noted above in the rejection under 35 U.S.C. 112, first paragraph, the originally filed disclosure of the instant application does not describe what is meant by "at rest" in the claims. Accordingly, the term must be given its broadest reasonable meaning. MPEP § 2111. Merriam-Webster's dictionary

defines "rest" to be "a state of motionlessness or inactivity."¹ Such a definition comports with the mold shown in figures 3, 6, and 8 of Henning, and with Henning's specification. In none of these figures, is the mold in a state of motion. Thus, Henning discloses in figure 6 the mold to be such that the edges of the notches do not touch each other over at least a major part of their length when the mold is at rest.

13. Claims 80-81 and 101 are allowed. See the reasons for indicating allowable subject matter in the previous Office Action.

14. Claim 119 would be allowable if rewritten to overcome the rejections under 35 U.S.C. 112, first paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (703) 308-6371. The

¹ Merriam-Webster's Collegiate Dictionary, 10th ed., 1998, p. 998.


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examiner can normally be reached on Monday through Friday from
9:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are
unsuccessful, the examiner's supervisor, Wanda Walker, can be
reached at (703) 308-0457. The official fax phone number for
the organization where this application or proceeding is
assigned is (703) 972-9306. The unofficial fax phone number is
(703) 305-3602.



Donald Heckenberg
November 20, 2003



JAMES P. MACKEY
PRIMARY EXAMINER

11/24/03